

Application Serial No. 09/888,214
Response to June 2, 2005 OA

LO25-003

REMARKS

Claims 1-3, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Marmo et al ('276).

Claim 1 recites connecting the plurality of the individual optical elements to the basic body by a galvanoplastic joining technique. During the Examiner Interview with Examiner Shafer on July 29, 2005, the Examiner clarified his understanding of the teaching of Marmo and the pending anticipation rejection against claim 1. Referring to Fig. 9 of Marmo, the Examiner relies on the following to allegedly teach the positively recited body: master plate 28, spacer bars 31 and separator bars 32. Still referring to Fig. 9 of Marmo, the Examiner relies on mirror segments 24 to allegedly teach the positively recited optical elements. Referring to Fig. 10 of Marmo, the Examiner relies on the following to allegedly teach the positively recited connecting ... by galvanoplastic joining technique: electrodeposited nickel 34 formed conformally over the master plate 28, spacer bars 31, separator bars 32 and mirror segments 24. The Examiner relies on this teaching to reject the positively recited limitation to, connecting the plurality of the individual optical elements to the basic body by a galvanoplastic joining technique.

However, in no fair or reasonable interpretation does forming nickel conformally over structures teach or suggest connecting the optical elements to the basic body as positively recited in claim 1. Federal Circuit authority and the

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MPEP clearly indicate that the Examiner is improperly interpreting the teachings of Marmo. The Examiner is respectfully reminded that claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003); MPEP §2111.01 II. (8th ed., revision no. 2). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and "customary" meaning of the terms in the claims. (citations to the Federal Circuit omitted); MPEP §2111.01 II. The ordinary and customary meaning of a term may be evidenced by a variety of sources, including: the claims themselves, dictionaries, drawings and the written description (citations to the Federal Circuit omitted); MPEP §2111.01 II. If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. *Brookhill-Wilk 1*, 334 F.3d at 1300, 67 USPQ2d at 1137 (emphasis added); MPEP §2111.01 II.

Marmo teaches prior to the electroforming of nickel 34, master 30 is passivated to "produce a selective electrodeposited nickel bond to the separator bars while preventing a bond to master [mirror] segments 24." (col. 7, lns. 10-

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25). Accordingly, in the first instance, the electroformed nickel 34 of Marmo is not even bonded to the mirror segments 24, and therefore, it is inconceivable that the electroformed nickel 34 teaches or suggests connecting the mirrors 24 to any structure by the electroformed nickel 34. Consequently, it is inconceivable that such teaching of Marmo teaches or suggests connecting the optical elements to the basic body by a galvanoplastic joining technique as positively recited in claim 1.

Moreover, Applicant submits the Examiner is not properly interpreting the ordinary and customary meaning of the terms connecting the optical elements to the basic body by a galvanoplastic joining technique, and definitely is not attributing the ordinary and customary meaning of the terms as presented by one skilled in the art, pursuant to the above authority. Given this situation of the Examiner providing a interpretation of the terms other than ordinary or customary by one skilled in the art, and again pursuant to the above authority, Examiner must consult the intrinsic record (the originally-filed application) to identify which of the different possible definitions is most consistent with applicant's use of the terms. The proper interpretation of connecting the optical elements to the basic body by a galvanoplastic joining technique, based on the written description, is that the optical elements and basic body are "connected to one another ... as virtually a single monolithic part" (para. 0021, pg. 5). The optical elements and body "grow together as one unit" (para. 0023, pg. 6). These

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teachings of the written description clearly indicate that the connecting by a galvanoplastic joining technique can be characterized as a permanent connection of the optical elements, and the optical elements are directly connected to the basic body.

However, Marmo teaches that electroformed nickel 34 is not even bonded to the mirror segments 24 (col. 7). Accordingly, the mirror segments 24 could not possibly be characterized as being connected to the bars 31 and 32 of Marmo, and definitely can not be reasonably stated to be a permanent connection directly to bars 31 and 32. Additionally, Marmo teaches that the electroformed nickel 34 is removed from the mirror segments 24 and bars 31 and 32 as shown in Figs. 12-13. No reasonable interpretation of the this reference can be stated to teach or suggest the connecting the optical elements to the basic body by a galvanoplastic joining technique as positively recited by claim 1.

Consequently, the Examiner has failed to use the ordinary and customary meaning of the terms recited claim 1 as is attributed by one skilled in the art, pursuant to the above authority. Moreover, the Examiner has failed to use the ordinary and customary meaning of the terms recited claim 1 as identified by referring to applicant's use of the terms as evidenced by the written description, pursuant to the above authority. For either one of these reasons, the Examiner has failed to provide a proper anticipation rejection against claim 1 based on

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Marmo. Marmo fails to teach or suggest connecting the plurality of the individual optical elements to the basic body by a galvanoplastic joining technique as positively recited in claim 1. Claim 1 is allowable.

Claims 2-4, 22-25 and 28-30 depend from independent claim 1, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

The drawings are objected to for allegedly introducing new matter pursuant to 35 U.S.C. §132 because, as the Examiner states, Fig. 2b includes an intermediate layer (10) between adjacent mirror elements (9) which is considered to be new matter. The specification was previously amended to be consistent with Fig. 2b, and therefore, the specification is also objected to as having new matter. These objections are inappropriate and should be withdrawn. The Examiner is respectfully reminded that the MPEP clearly indicates that by disclosing in a patent application a device that inherently performs a function or has a property, or operates according to a theory, that patent application necessarily discloses that function or theory even though it says nothing explicit concerning it. MPEP §2163.07(a) (8th ed., revision no. 2). The application may later be amended to recite the function or theory without introducing prohibited new matter. (Federal Circuit citations omitted); MPEP §2163.07(a). "To establish inherency, the extrinsic evidence 'must make clear that the missing

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descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP §2163.07(a).

Applicant previously submitted a Declaration by Ulrich Bingel, a person skilled in the art, pursuant to 37 C.F.R. §1.132 (see response mailed 8-23-04). In the instant case, this declaration is the extrinsic evidence, pursuant to the above authority, that makes clear that the missing descriptive matter, that is Fig. 2b and the associated amended specification, are necessarily present by inherency in the originally-filed application and would be recognized by one skilled in the art. Accordingly, the addition of Fig. 2b and language to the specification describing Fig. 2b is not new matter and is appropriate.

That is, it would be so recognized by persons of ordinary skill that Fig. 2 and the originally-filed application clearly illustrate that basic body 8, intermediate layer 10 and optical elements 9 are arranged as understood in Fig. 2b, particularly since Fig. 2b is a side view of Fig. 2. Applicant submits Fig. 2b is inherent from the originally-filed disclosure, including Fig. 2. Further evidence of the inherency of Fig. 2b with respect to Fig. 2 is demonstrated by the Declaration at, for example, para. (g). Applicant submits that since Fig. 2b is inherent from the originally-filed application, pursuant to the above authority presented by the Federal Circuit and the MPEP, that the objections to Fig. 2b

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and the specification as being new matter are inappropriate and should be withdrawn.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 8.2.05

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